



7234-111N1
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KRAIG A. KIRSCHNER

Serial No. 10/759,873

Filed: January 16, 2004

For: SEISMIC ADAPTER

Group Art Unit: 1713

Examiner: James R. Brittain

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being deposited this day, September 3, 2004, with the United States Postal Service as first class mail in an envelope addressed to Mail Stop: Non-Fee Amendment, Commissioner for Patents and Trademarks, P. O. Box 1450, Alexandria, Virginia 22313-1450.

John D. McConaghy, Reg. No. 26,773

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Commissioner:

The following is in response to the Official Action mailed June 3, 2004.

Before responding to the Official Action, it is noted that the U.S. Application upon which the present application claims priority has been issued as U.S. Patent No. 6,749,359 on June 15, 2004.

Turning to the non-statutory double patenting rejection based on judicially created doctrine, Applicant does not affirm the basis for the rejection on the aforementioned parent application in light of Rebentisch, U.S. Patent No. 4,784,552. This issue will be treated together with the statutory rejections.

Before turning in detailed to the rejections under 35 U.S.C. 103, it is believed that a short discussion of the nature and purpose of the present invention is in order. The

present invention is directed to a seismic adapter for attachment to a beam of a web joist. The combination is distinguished over Applicants' prior device by the engagement plate which has upstanding engagement portions to either side of a flat anchor portion. Each upstanding engagement portion is at an obtuse angle substantially greater than 90° to the flat anchor portion and has a distal edge with an engagement profile abutting and being an interlocking engagement with the beam. The advantages of this device over Applicant's prior device includes a mechanism allowing flexibility, greater lateral location and stability and the imposition of anchoring forces which achieve a higher contact pressure and an advantageous angle of approach to the anchoring contact. These are achieved through the recitations in the rejected claims of the "upstanding engagement portions", the "obtuse angle greater than 90° to the flat anchor portion" of the engagement portions and the distal edges, each with "an engagement profile abutting and being an interlocking engagement" with the beam. The applied references do not define structures able to satisfy the requirements for a *prima facie* case of obviousness under 35 U.S.C. 103.

MPEP Section 2142 states the basis for a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation.

Claims 1 and 2 were rejected as obvious over the description of Applicant's prior seismic adaptor in view of Koyama, U.S. Patent No. 5,259,165, and Rebentisch.

Applicant's prior seismic adapter is described in the Official Action. Effectively and in

summary, this prior seismic adapter includes an upper plate, a lower plate and a stud therebetween with only the flat lower plate being replaced by the engagement plate in claim 1 presently at issue. The engagement plate is novel beyond the "flat anchor portion".

Koyama employs two formed structures held on a beam by a common stud. These structures 2 and 3 are principally formed to retain the two angle elements of the beam in place and, therefore, are part of the beam structure. Koyama fails to provide "upstanding engagement portions" with each portion being "at an obtuse angle substantially greater than 90° to the flat anchor portion". Koyama does provide engagement interaction with the beam.

Rebentisch is applied in the Official Action with the assertion:

...Rebentisch teaches that it would have been further obvious to have the upstanding engagement portion 24 extending at an obtuse angle substantially greater than 90° from the flat anchor portion so as to form a biting edge to grip the legs 26 to thereby more securely hold the engagement plate to the channel and prevent it from moving....

Of course, the nut 10 of Rebentisch is not a plate but a formed concaved structure operating as a nut. This nut 10 does not have distal edges each "with an engagement profile abutting and being an interlocking engagement" with a beam or other supporting structure to define an anchor upon which some further element is to be attached. Rather, the nut 10 captures the supported item, the channel 30. The nut 10 defines flanges 24 tapering to an edge and does not provide a plate with "upstanding engagement portions to either side of the flat anchor portion". Indeed, there is no flat anchor portion either.

In the foregoing analysis, it is observed that the prior seismic adapter has no upstanding engagement portions, Koyama has no angled portions and Rebentisch has no engagement plate, no flat anchor portion and no upstanding engagement portions of a plate at any angle. As such, the combination of references fails to teach or suggest all of the claim limitations. The third criteria for a *prima facie* case of obviousness cannot be met by these references.

The prior seismic adaptor and Koyama clamp to a beam of a webbed joist and each has the ability to attach an element to be suspended therefrom. Even so, the focus of Koyama is to provide elements which help define the beam rather than suspend components from the beam. Nothing whatsoever about the seismic adapter teaches or suggests that that device might be amended to become part of the beam structure. This is even more true in that the device of Koyama cannot be positioned on a beam which is already in place in a structure or on a web joist which is already assembled. The element 3 must be positioned from the end of the beam. This limitation of Koyama makes the device of substantially no value to a seismic adapter. As such, the features of Koyama are neither suggested nor of particular value to the prior seismic adapter. There being no suggestion or motivation for the incorporation of Koyama into the structure of the prior seismic adapter, the first criteria for a *prima facie* case of obviousness as set forth in MPEP § 2142 also cannot be supported.

The application of Rebentisch to that of the prior seismic adapter is also without basis. The prior seismic adapter is designed to anchor onto a beam of a web joist. That anchor then provides an attachment to which utility components and the like can be affixed. Rebentisch, on the other hand, provides no such anchor. Rather, it simply

bolts together a plate and that which is to be attached, the channel 30. Thus, the basic nature of Rebentisch has nothing to do with the purpose and arrangement of the prior seismic adapter. As there is no suggestion or motivation for any such combination of these diverse structures and functions, the first criteria for a *prima facie* case of obviousness cannot be supported by the prior seismic adapter and Rebentisch.

Looking to the non-statutory rejection based upon the claims of U.S. Patent No. 6,749,359 in view of Rebentisch, the Official Action applies Rebentisch in the same way as in the statutory rejection, the application of the nut 10 as an engagement portion of a plate. The same observations apply as above. The seismic suspension system of the present application is also designed to anchor onto a beam. The same features are missing from Rebentisch and the same dichotomy of purpose exists between the device of the parent patent and that of Rebentisch. Both the first and the third criterias for a *prima facie* case of obviousness cannot be met by U.S. Patent No. 6,749,359 and Rebentisch.

Claim 3 was rejected over the references previously discussed with the addition of Steinke, U.S. Patent No. 4,408,928. As Claim 3 depends from Claim 1, the foregoing arguments are equally applicable to this rejection. Further, Steinke fails to provide any angled upstanding engagement element as set forth in the claims. Again, a *prima facie* case of obviousness cannot be sustained over Claim 3 in view of the applied references.

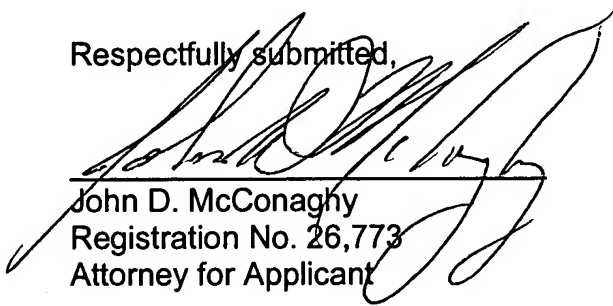
In the Official Action, the prior remarks of Applicant filed January 16, 2004, have been dismissed as to the advantages presented therein as not having been originally disclosed. The mechanism defined with the obtuse angle provides the ability to be

used, depending on the selection of the plate and its thickness, at varying degrees of resiliency. Thus, greater or lesser amounts of flexibility may be provided depending on obvious choices in plate rigidity. No advantage is recited in the claim, just the mechanism by which that advantage can be realized. Any lack of original disclosure of such advantages presented in the prior arguments or presented hereinabove is of no import. The mechanism is defined which allows one to realize the advantages available. Reference is made to MPEP §§ 716.02(f) and 2163.07(a) which specifically acknowledge that advantages inherent in the structure are appropriately considered during prosecution, regardless of their disclosure in the original application.

Thus, all of the claims in U.S. Patent No. 6,749,359, the prior seismic adapter, Koyama, Rebentisch and Steinke, taken independently or in combination, fail to provide support for a *prima facie* case of obviousness. The references fail to provide all of the limitations of the claims and fail to even suggest or motivate a combination there among. The differences are substantial as presented in the asserted advantages of the present invention. According to the criteria defined in MPEP § 2142, a *prima facie* case of obviousness cannot be established. Consequently, a Notice of Allowance is earnestly solicited.

Respectfully submitted,

September 3, 2004



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